

REMARKS

Claims 1-8 and 17 have previously been cancelled. Applicant has amended claims 9-11, 14-16, 19-21, to further clarify inventive aspects of the invention and currently cancelled claims 18, 22-23. Claims 9-16, 19-21 are pending in this application.

In the Office Action dated May 21, 2004, The Examiner objected to claim 18 because it depended from cancelled claim 17. The Examiner also rejected claims 9, 10, 12, 14-16, 19, 20, and 22 under 35 U.S.C. 103(a) as being unpatentable over Wiecha (U.S. Patent No. 5,870,717) in view of LeRoy et al. (U.S. Patent No. 5,970,474) and claims 11, 18, and 21 in further view of DeBusk et al. (U.S. Patent No. 5,991,728).

The undersigned has reviewed the May 21, 2004, Office Action and respectfully traverses all rejections for the reasons set forth herein. No new matter has been added. The undersigned respectfully requests that all pending claims, as amended, be allowed.

A. Overview

The present invention is directed to methods and systems that allow three or more people to coordinate to order products associated with a medical procedure. Two people each order one or more products identified with a medical procedure and a third person provides authorization to purchase the products. The present invention provides for each person to be associated with a client set and a reduced price to be applied according to discounts available based upon an aggregate of the products ordered by disparate members of the client set.

B. Claim Objections

Examiner has rejected claim 18 because it depended from cancelled claim 17. The Applicant has amended claim 18 to depend from currently pending claim 9. Withdrawal of the objection is respectfully requested.

C. Rejections under 35 U.S.C. 103

Examiner has rejected claims 9, 10, 12, 14-16, 19, 20, and 22 under 35 U.S.C. 103(a) as being unpatentable over Wiecha (U.S. Patent No. 5,870,717) in view of LeRoy

et al. (U.S. Patent No. 5,970,474) and claims 11, 18 and 21 in further view of DeBusk et al. (U.S. Patent No. 5,991,728).

To establish a case of obviousness, the Examiner must meet three basic criteria. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references' teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. MPEP 706.02(j), citing In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Further a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). The cited art does not meet these criteria as they apply to the currently pending claims.

Weicha is directed to an electronic catalog accessible from a personal computer for ordering supplies. Weicha describes various servers and functionality that one might expect to find in an online ordering system. In addition, Weicha describes a means that allows an online ordering system to be integrated with a legacy ordering system.

However, Weicha does not describe or teach several aspects of the presently claimed invention. Weicha does not associate a medical procedure with an order, nor does Weicha allow two clients to coordinate ordering supplies associated with a procedure by allowing each client to specify at least one product associated with the medical procedure and included in one order. In addition, Weicha does not describe or suggest a reduced price for products associated with a medical procedure according to an aggregate of products ordered by a client set of people. Therefore, all of the claim limitations in the currently pending independent claims are not taught or suggested by Weicha and there is no suggestion or motivation to modify Weicha to incorporate the missing elements.

LeRoy does not make up for Weicha's deficiencies. LeRoy describes an information system for automating a gift registry. A potential recipient of a gift can register with a retail establishment and indicate which products offered for sale by the

store they would be interested in receiving as a gift. According to LeRoy, a point of sale device can then verify that a purchased item is associated with a registry database of a particular registrant. The Examiner points out that at col. 5 lines 41-51, a shopper can access the gift registry via a public access system , such as the Internet. The gift registry is designed to help a gift giver select an appropriate gift.

However, like Weicha, LeRoy fails to describe or suggest associating products with a medical procedure or enabling two clients to coordinate ordering supplies associated with the medical procedure by allowing each client to specify at least one product included in a multiple product order, where each part is associated with the medical procedure.

The Examiner also points out that DeBusk is directed to a method and system for ordering medical supplies. DeBusk includes a description of how supplies and resources can be associated with specific care events (medical procedures). However, DeBusk fails to describe or suggest two people coordinating an order for items related to a medical procedure or for applying discounts according to an aggregate of items ordered by a client set of users. Therefore, DeBusk cannot make up for Weicha and LeRoy failing to teach or suggest all of the claimed elements in the currently pending independent claims, nor has any motivation been provided to combine technology from the disparate areas of a gift giving, corporate procurement and supply usage in a clinical setting.

Accordingly, the Applicant respectfully submits that a case of obviousness has not been met in regards to the independent claims 9, 19 and 20 because the cited art as failed to: (a) demonstrate that the prior art references describe or suggest all of the claimed limitations of the present invention, and (b) show a motivation to modify or combine the references.

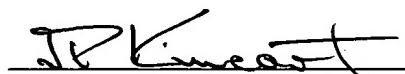
In addition, dependent claims 10-16, 18 and 21 include additional elements that are not described or suggested by the cited art. Dependent claims 10 and 11 include the additional claim limitations of specifically relating an order for items with a specific doctor. Claim 12 specifically includes the Internet as the defined network and claim 13 specifically includes the step of transmitting a substitute for a product. Claim 14 additionally comprises pricing that is based upon a customer account. Claims 15 and 16 include transmitting an indication of the order to the second client (authorizing client)

and the second client submitting an order, respectively. Claim 21 includes computer media containing computer instructions for receiving an and storing an order comprising multiple products both used in a single medical procedure. In combination with the respective independent claims, each of the dependent claims is unique for at least the reasons set forth above and in addition for their individual unique contributions.

Conclusion:

Applicants respectfully submit that the foregoing amendments and remarks place all of the pending claims in condition for allowance and accordingly requests that all pending claims, as amended, be allowed. Should the Examiner have any additional concerns, the Applicant requests that the Examiner contact the undersigned at (904) 443-3731.

Respectfully submitted,



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